UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN ALEX LEONARD
and
MAURICE TINKLER

Appeal No. 2004-2241
Application No. 10/059,577

ON BRIEF

Before KIMLIN, WARREN and DELMENDO, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-15, 26, 27, 30 and 31. Claim 1 is illustrative:

1. A method of producing an aqueous solution of thermodynamically free iodine from iodine vapor transferred across a porous membrane from an iodine source, comprising the following steps:

selecting a porous membrane that is permeable to iodine and water vapor but impermeable to liquids and solids;

providing a source of iodine vapor;

providing such membrane in the form of an enclosure to contain the source of iodine vapor;

providing a vessel that contains a receiving medium for the iodine vapor; and

permeating iodine vapor across the membrane.

In the rejection of the appealed claims, the examiner relies upon the following references:

Koch	4,483,771	Nov. 20, 1984
O'Dowd	5,275,736	Jan. 4, 1994

Appellants' claimed invention is directed to a method of making an aqueous solution of thermodynamically free iodine. The method entails transferring iodine vapor across a porous membrane that is impermeable to liquids and solids.

Appealed claims 1-5, 7, 9, 10, 13, 26, 27, 30 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by O'Dowd. Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Dowd. In addition, claims 6, 8, 11, 12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Dowd in view of Koch, whereas claims 1-3, 5-14, 26, 27, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koch in view of O'Dowd.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find that the examiner's rejections are not well-founded. Accordingly, we will reverse the examiner's rejections for essentially the reasons expressed in appellants' principal and reply briefs.

We consider first the examiner's § 102 rejection over O'Dowd. O'Dowd, like appellants, is directed to a method for producing thermodynamically free iodine. However, as acknowledged by the examiner, O'Dowd does not employ the presently claimed porous membrane but, rather, a solid barrier through which the free iodine passes by dispersion. It is the examiner's position that, although the term "porous" is not equated with "permeable," "the porous membrane, as defined by the applicant, encompasses the non-porous barrier taught by the reference" (page 7 of Answer, first paragraph). The examiner cites page 7 of appellants' specification for the proposition that appellants "have covered every possible membrane and membrane material with the only specific limitation being that the pore size is less than 5 microns" (page 7 of Answer, second paragraph). According to the examiner, "[o]ne of ordinary skill

in the art would readily recognize that the O'Dowd teaching of 'non-porous material' falls within these bounds" (id.).

Our review of appellants' specification finds nothing that would indicate that the claimed porous membrane includes the non-porous material of O'Dowd. We agree with appellants that the specification clearly teaches that whatever material is chosen for the membrane, it must be a porous material having a pore size no greater than 5 microns. While the examiner states that the specification places no lower limit on the pore size, we do not subscribe to the examiner's implication that a membrane having a pore size of 0 microns, i.e., a membrane without pores, is within the scope of the claimed porous membrane. By definition, the claim language "porous membrane" necessarily defines a membrane having pores therein. The porous nature of the claimed membrane serves as a distinction over the solid barrier that is permeated by iodine vapor in accordance with the description in O'Dowd at column 4, lines 6 et seq. It is well known in the art that non-porous membranes may be permeable to certain materials by various mechanisms.

Concerning the § 103 rejection of claim 15 over O'Dowd, and the § 103 rejection of claims 6, 8, 11, 12 and 14 over O'Dowd in view of Koch, the examiner has not explained why it would have

been obvious for one of ordinary skill in the art to modify the non-porous barrier of O'Dowd.

As for the § 103 rejection over Koch in view of O'Dowd, the examiner errs in stating that "Koch teaches a method of producing aqueous solution of iodine from iodine transferred across a porous membrane that is permeable to vapors but impermeable to water or solids (Fig. 2, col 3 lines 7-55)" (page 5 of Answer, penultimate paragraph). As emphasized by appellants, Koch, unlike O'Dowd, is not directed to transferring free iodine across a membrane into a solution. Rather, Koch discloses a multi-layer filter comprising medication, such as iodine, for inhibiting the transfer of bacteria through the filter. Our review of Koch at column 3, lines 7-55, cited by the examiner, finds no teaching of producing an aqueous solution of iodine from iodine that is transferred across a porous membrane. In relevant part, Koch discloses that "[m]acrofilter layer 10 can be impregnated with any aqueous or powdered bacteria-destroying material, for example antibiotics . . . iodine . . ." (column 3, lines 24-29). Any transfer of iodine from the filter into an aqueous solution would be unintentional. Accordingly, we concur with appellants that Koch and O'Dowd are not properly combinable.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROMULO H. DELMENDO Administrative Patent Judge	)	

ECK:clm

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